

means to include threads, splines, and/or knurling or the sub and receptacle (Col. 3, lines 7-21). Furthermore, Barahia et al. describe the auxiliary bearing assembly as a low resistance path from the rotor shaft through the auxiliary bearing shaft to ground (Col. 3, lines 62-64). Accordingly, because the rotor shaft and the auxiliary bearing assembly are mechanically attached and form a low resistance path, Applicant respectfully submits that the auxiliary bearing assembly is not a charge concentrator.

Newberg describes a bearing retainer structure comprising an endshield (2), a bearing support means in the form of an annular support lip (12), and an annular space (19). More specifically, the annular space is provided to receive an expansible-compressible fastening device (21) which retains the bearing (14) in position to enhance the resistance to torsional, axial, and radial thrusts (Col. 3, lines 44-46).

Applicant respectfully submits that the Section 103 rejection of the presently pending claims is not a proper rejection. As is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. Neither Barahia nor Newberg, considered alone or in combination, describe or suggest the claimed combination. Furthermore, in contrast to the assertion within the Office Action, Applicant respectfully submits that it would not be obvious to one skilled in the art to combine Barahia with Newberg, because there is no motivation to combine the references suggested in the art. Additionally, the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicant's own teaching. Rather, only the conclusory statement that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Barahia bearing current reduction assembly with the teaching of Newberg bearing retainer structure to eliminate or reduce the build up of electric potentials on the shaft or in bearings of the motor" is provided as support for combining the disclosures.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicant's disclosure, in the prior art to combine such

references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicant's disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion or motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Furthermore, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the cited art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The present Section 103 rejection is based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Specifically, Barahia et al. is cited for its teaching of an auxiliary bearing assembly mechanically connected to a rotor shaft, and Newberg is cited for its teaching of a bearing retainer structure comprising an endshield and a bearing support means in the form of an annular support lip. There is no teaching or suggestion in the cited art for the claimed combination, and as such, the Section 103 rejection appears to be solely based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Such a combination is impermissible, and for this reason alone, Applicant requests that the Section 103 rejection of Claims 1-12 be withdrawn.

Furthermore, and to the extent understood, neither Barahia et al. nor Newberg, considered alone or in combination, describe or suggest, the claimed combination, and as such, the presently pending claims are patentably distinguishable from the cited combination. Specifically, Claim 1 recites "a bearing current reduction assembly comprising a rotor shaft; and an inner bearing cap substantially radially aligned with said rotor shaft, said the inner bearing cap comprising an inner end, said inner end in close proximity to said rotor shaft; and a charge concentrator disposed on at least one of said rotor shaft and said inner end."

Neither Barahia et al. nor Newberg, considered alone or in combination, describe or suggest a bearing current reduction assembly comprising a charge concentrator that is disposed

on at least one of the rotor shaft and the inner end. Rather, Barahia et al. appears to teach away from the present invention. More specifically, Barahia et al. describe an auxiliary bearing assembly wherein the auxiliary bearing assembly is mechanically connected to the rotor shaft such that it provides a low resistance path to ground. Furthermore, Applicant submits that it would not have been obvious to alter Barahia et al. in view of Newberg to obtain the claimed invention. More specifically, as described above, Newberg teaches the use of a bearing retainer structure comprising an endshield and an annular support lip, and Barahia et al. teach mechanically engaging and contacting the auxiliary bearing shaft to the rotor shaft to provide a low resistance path to ground and therefore the auxiliary bearing shaft is inherently not a charge concentrator. For at least the reasons set forth above, Claim 1 is submitted to be patentable over Barahia et al. in view of Newberg.

Claims 2-6 depend, directly or indirectly, from independent Claim 1. When the recitations of Claims 2-6 are considered in combination with the recitations of Claim 1, Applicant submits that dependent Claims 2-6 likewise are patentable over Barahia et al. in view of Newberg.

Claim 7 recites an electric motor assembly comprising "a motor housing, a stator mounted in said housing and comprising a bore therethrough, a rotor core rotatably mounted in said housing and extending through said stator bore, a rotor shaft extending through said rotor core, at least one endshield, an inner bearing cap radially aligned with said rotor shaft, said inner bearing cap having an inner end and an outer end, said inner end in close proximity to said rotor shaft, and a charge concentrator disposed on at least one of said rotor shaft and said inner end."

Neither Barahia et al. nor Newberg, considered alone or in combination, describe or suggest an electric motor assembly including "a charge concentrator disposed on at least one of the rotor shaft and the inner end." Rather, Barahia et al. appears to teach away from the present invention. More specifically, Barahia et al. describe an auxiliary bearing assembly wherein the auxiliary bearing assembly is mechanically connected to the rotor shaft such that it provides a low resistance path to ground. Furthermore, Applicant submits that it would not have been obvious to alter Barahia et al. in view of Newberg to obtain the claimed invention. More specifically, as described above, Newberg teaches the use of a bearing retainer structure

comprising an endshield and an annular support lip, and Barahia et al. teach mechanically engaging and contacting the auxiliary bearing shaft to the rotor shaft to provide a low resistance path to ground and therefore the auxiliary bearing shaft is inherently not a charge concentrator. For at least the reasons set forth above, Claim 7 is submitted to be patentable over Barahia et al. in view of Newberg.

Claims 8-12 depend from independent Claim 7. When the recitations of Claims 8-12 are considered in combination with the recitations of Claim 7, Applicant submits that dependent Claims 8-12 likewise are patentable over Barahia et al. in view of Newberg.

For the reasons set forth above, Applicant respectfully requests that the Section 103 rejection of Claims 1-12 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



Thomas M. Fisher
Registration No. 47,564
ARMSTRONG TEASDALE LLP
One Metropolitan Square, Suite 2600
St. Louis, Missouri 63102-2740
(314) 621-5070